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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------|-------------|----------------------|---------------------|------------------|
| 10/751,378 | 01/05/2004 | Shoichiro Usui | F-8098 | 2639 |
| 28107 | 7590 | 05/12/2006 | EXAMINER | |
| JORDAN AND HAMBURG LLP | | | FORD, JOHN K | |
| 122 EAST 42ND STREET | | | | |
| SUITE 4000 | | | ART UNIT | PAPER NUMBER |
| NEW YORK, NY 10168 | | | | 3753 |

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/751,378 | USUI, SHOICHIRO | |
| | Examiner John K. Ford | Art Unit 3753 | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | | |
| Period for Reply | | | |
| <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>4/28/06</u></p> <p>2a)<input checked="" type="checkbox"/> This action is FINAL. 2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p> | | | |
| Disposition of Claims | | | |
| <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-7</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-7</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p> | | | |
| Application Papers | | | |
| <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p> | | | |
| Priority under 35 U.S.C. § 119 | | | |
| <p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> | | | |
| <p>* See the attached detailed Office action for a list of the certified copies not received.</p> | | | |
| Attachment(s) | | | |
| <p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.</p> | | <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p> | |

Applicant's response of April 28, 2006 has been careful consideration. Applicant did not traverse the substance of the previous rejections and therefore the examiner expects that there will be no new arguments in response to essentially those same rejections set forth here, wherein the rejections of claims 6 and 7 in the previous office action are now applied to all of claims 1-7 here. The previous office action has been edited to re-designate the new claim numbers.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as obvious over Charlton et al (USP 5,732,688) in view of JP 2001-173519 and, optionally, JP 03-183919 and additionally any one of JP 2003-278544, JP 2002-285843, Plaff et al (USP 6,343,572), Derwent publication 2002-423613, JP 08-261071 or Saito et al (USP 6,758,173).

Charlton discloses an EGR cooler in Figures 2 and 3 that has a valve 86 controlling the engine coolant flow responsive to exhaust gas temperature to maintain the exhaust gas temperature at roughly 150 degrees C (see Figure 4, far right), for the purpose of reducing fouling of the EGR cooler (col. 8, lines 54-59). Charlton senses exhaust gas temperature indirectly using housing temperature sensor 98. Charlton also

discloses a second temperature sensor for sensing EGR gas outlet temperature (sensor 94) and a coolant medium outlet temperature sensor 90. JP 2001-173519 shows a jacket sensor 62 similar to the jacket sensor 98 in Charlton. In paragraph 0045 of the machine translation of '519 attached thereto, it is disclosed that as an alternative to the jacket temperature, the wall surface 56a temperature could be used instead. To have modified Charlton's jacket sensor 98 by placing it on one of the EGR heat exchanger tubes instead of the jacket wall would have been obvious in view of this teaching of equivalency from paragraph 0045 of JP '519. It would appear that one advantage to this latter configuration (i.e. tube wall temperature sensing) is faster response to changing conditions. JP 03-183919 is cited simply to show that mounting temperature sensors on tube walls is old and well known in the art. .

Regarding the 120-150 degree C limitation in claim 5, to have set the minimum temperature to any particular value in the 120-150 degrees C range to advantageously prevent fouling would have been obvious to one of ordinary skill since it appears from Charlton that temperatures in this range reduce fouling and would have been obvious to one of ordinary skill for that reason.

Regarding the boiling point of the coolant, Charlton explicitly contemplates high temperature coolants (with boiling points higher than conventional water-glycol engine coolant fluid) in col. 6, lines 39-51, which is incorporated here by reference. Moreover, since claim 1 only requires the boiling point to be greater than 150 degrees C, official

notice is taken of the fact that conventional water-glycol engine coolant fluid (ethylene glycol based products such as "ZEREX" and other antifreeze sold in supermarket and auto-supply stores in the United States) have a boiling point of 106 degrees C (in a 50/50 mix with water) at atmospheric pressure. At higher pressures the ethylene glycol boils at high temperatures. For example, at 14-15 psi above atmospheric pressure the boiling point such antifreeze increases to 131 degrees C. At even higher pressure the boiling point rises to 150 degrees C and then higher as pressure goes up further. This behavior is shown in col. 10, lines 40-60 of USP 5,868,105, which forms no part of this rejection except to show conventional knowledge in the field. Therefore, Charlton, by disclosing that his coolant has a boiling point higher than conventional water-glycol engine coolant fluid is deemed to be inherently disclosing coolant with a boiling point above 150 degrees C. The coolant temperature in Charlton (see Figure 4) is approximately 100 degrees C, and that Charlton in col. 6, lines 31-51 contemplates using coolants with higher boiling points than conventional water-glycol coolants. Specifically at least 110 degrees C is contemplated in col. 8, lines 46-50 as a coolant temperature. Thus, the boiling point of the coolant in Charlton must be at least 110 degrees C. To have selected 150 degrees C coolant so that there was some margin of safety to advantageously avoid "boil-over" would have been obvious.

Finally, the prior art to JP 2003-278544, JP 2002-285843, Plaff et al (USP 6,343,572), Derwent publication 2002-423613, JP 08-261071 or Saito et al (USP 6,758,173), each individually teach an exhaust gas cooler that is connected to a liquid

circulating coolant circuit that has an expansion tank associated with it. See JP 2003-278544, tank 35 and the description thereof, JP 2002-285843, tank 23 with a liquid coolant level "x", Plaff et al (USP 6,343,572), with exhaust gas cooler 17 and expansion tank 25, Derwent publication 2002-423613, EGR cooler 15 and reservoir tank 39, JP 08-261071, EGR cooler 13 and reserve tank 11 or Saito et al (USP 6,758,173), EGR cooler 31 and an expansion tank shown (but not described) to the right of radiator 27. In view of anyone of these teachings it would have been obvious to have equipped the system of Charlton (Figure 2) with an expansion tank to take up the temperature induced expansion of the coolant so that the system advantageously wouldn't explode or undergo extreme temperature induced expansion and damage during use.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1-7 above, and further in view of JP '956 and optionally Malatto et al or Paas (USP 5,785,030).

JP '956 discloses an EGR cooler 20 that has a valve 40 controlling the engine coolant flow responsive to exhaust gas temperature to maintain the exhaust gas temperature at a minimum of "for example, 100 degrees C", for the purpose of preventing the formation of sulfuric acid in the exhaust. This is disclosed at step S28 in Figure 2 where the question is posed: Is EGR gas temperature greater than or equal to T3? In the disclosure an example temperature of 100 degrees C is given for T3. If the answer is "No" then the water valve 40 is set to a minimum position. This adds further

credence to the remarks above that temperatures in a range of 120 degrees C and 150 degrees C are desirable from the standpoint of avoiding fouling and degradation of the cooler by the action of the somewhat caustic nature of the exhaust gasses themselves.

Malatto merely teaches lubricating oil as an extremely high boiling point engine coolant (well over 150 degrees C, typically about 300 degrees C), which would have also been obvious to have used for the reasons discussed in Malatto.

Similarly, Paas teaches cooling exhaust gasses in an EGR cooler to temperatures not exceeding 300 F (150 degrees C). This adds further credence to the remarks above that temperatures in a range of 120 degrees C and 150 degrees C are desirable from the standpoint of avoiding fouling and degradation of the cooler by the action of the somewhat caustic nature of the exhaust gasses themselves.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to John Ford at telephone number 571-272-4911.



John K. Ford
Primary Examiner